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ID

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/608,066	06/30/00	ASTATKE	M 0942.4990001

HM22/1201  
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EXAMINER

TAYLOR, J

ART UNIT

PAPER NUMBER

1655

5

DATE MAILED:

12/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

**Application No.**

09/608,066

**Applicant(s)**

ASTATKE ET AL.

**Examiner**

Janell Taylor Cleveland

**Art Unit**

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 13 October 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-59 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).



### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11 and 30-31, drawn to a composition, classified in class 435, subclass 6.
  -  II. Claims 12-18, drawn to a method for synthesizing a nucleic acid molecule, classified in class 435, subclass 91.1.
  - III. Claims 19-24 and 32, drawn to a method for amplifying a nucleic acid molecule, classified in class 435, subclass 91.1
  -  IV. Claims 25-29, drawn to a method for sequencing a nucleic acid molecule, classified in class 435, subclass 6.
  - V. Claims 33-34, drawn to a method of preparing cDNA from mRNA, classified in class 435, subclass 91.51.
  - VI. Claims 35, drawn to a method of inhibiting or preventing nucleic acid synthesis, classified in class 435, subclass 183.
  - VII. Claims 36-42, drawn to an oligonucleotide, classified in class 435, subclass 6.
  - VIII. Claims 43-46, drawn to a method of inhibiting a polymerase enzyme within a cell, classified in class \*\*435\*, subclass 183.
  - IX. Claims 47-51, drawn to a method of inhibiting replication of a virus, classified in class 435, subclass 236.

- X. Claim 52, drawn to a method of treating a viral infection in a subject, classified in class 424, subclass 278.1.
- XI. Claims 43-55, drawn to an oligonucleotide which binds or has an affinity for reverse transcriptases, classified in class 435, subclass 183.
- XII. Claims 56-57, drawn to a method of inhibiting one or more reverse transcriptases, classified in class 435, subclass 183.
- XIII. Claims 58-59, drawn to a method of treating a viral infection, classified in class 435, subclass 235.1.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I-XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to compositions and various methods with materially different method steps, each capable of use without the other.
- 3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
- 4. Because these inventions are distinct for the reasons given above and the search required for each group is not required for the other groups, restriction for examination purposes as indicated is proper.
- 5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janell Taylor Cleveland whose telephone number is 703-305-0273. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on 703-308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-8724 for regular communications and 703-308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Janell Taylor Cleveland  
Examiner  
Art Unit 1655

  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600

November 27, 2000